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TO: Commissioner for Patents - U.S. Patent Office

FAX NO.: 703-872-9306

FROM: R. Gale Rhodes, Jr.

DATE: 6/10/04

MATTER: Serial No. 10/757,208 Filed: 1/14/04

DOCKET NO.: 15254C

APPLICANT: Coburn

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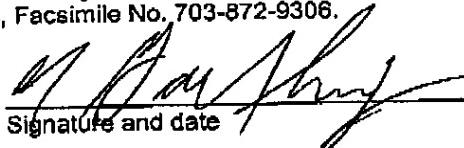
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IN THE UNITED STATES
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PATENT APPLICATION

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JUN 10 2004

Applicant(s): Joseph W Cobum, Jr.
Case No.: 15254C
Serial No.: 10/757,208 Filed: 1/14/04
Group Art Unit: 1772
Examiner: NORDMEYER, PATRICIA L.
Title: OPTICALLY DECORATIVE PRODUCT

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RESPONSE

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

This is in response to the Office Action of May 27, 2004. The Examiner's rejections of the claims are respectfully traversed.

By way of brief background, Applicant's invention is an optically decorative product for observation by the eye of a human observer and which product produces in the presence of light a color effect image which has an appearance other than that of an actual surface of the product. Applicant's invention is an optically decorative product of the same type as the Optically Decorative Web disclosed in U.S. Patent No. 3,908,056 to Anderson; note page 1, line 16 et seq. of the present application and which Anderson patent is incorporated into the present application by reference at page 2, line 25 et seq. as if fully reproduced in the present application. Anderson teaches an optically decorative product having a plurality of parallel ridges and grooves with the ridges being formed by facets defining a convex surface joined by surfaces forming steps connecting the

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adjacent facets and which produce an image different from a real or actual surface of the product; note Anderson at column 1, lines 49-58 and column 2, lines 41-53. Such optically decorative product is for decorating ceilings, vehicles, furniture, glass panels, signs or other articles utilizing decorative trim or requiring a protective strip, note Anderson column 2, lines 8-12 and the embodiments of Anderson shown in FIGS. 1, 2, 3, 4, 5, 6, 7, 8 and 10. Such plurality of ridges and grooves produces in the presence of light an image which has an appearance other than the surface of the layer of transparent material in which such ridges and grooves were formed and which image is other than coincident with the opposed surfaces of the layer of material in which such ridges and grooves are formed. Such optical image is for being viewed by the eye of a human observer or viewer—note Anderson, column 1, lines 14 and 36, column 2, line 43, column 3, lines 56-57, and column 4, line 13.

Referring to the rejection of claims 1-10 as being obvious over Futhey et al. in view of Tachikawa et al., this obviousness rejection is traversed. Futhey et al. neither teaches nor suggests the "plurality of parallel ridges and grooves..." and "an outer layer ... of color effect producing material ..." defined by independent claim 1, nor can the structure disclosed by Futhey et al. perform the function recited for the structure defined in independent claim 1, namely, the production of a color effect image such that the layer of transparent polymeric material in which such ridges and grooves are formed has an appearance other than that of the surface of such material and wherein such color effect image is other than coincident with the opposed surfaces of such material. Specifically, Futhey et al. discloses an optical film for simulating beveled glass. As further illustrated in FIGS. 3 and 4 of Futhey et al., and as described in the associated written description, Futhey discloses a transparent layer of optical material 30 adhered by adhesive 40 to a layer of glass 50. The top surface 34 of the optical material 30 is provided, as shown specifically in FIG. 4, with prism grooves 60 defined by a first substantially perpendicular facet 62 and a second angled facet 64. As illustrated by way of example in FIG. 11 of Futhey et al., upon light rays 140 striking the surface of the optical material 130 in which the grooves are

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formed, the light rays are reflected at the angled surface 138 with the angle of incidence equaling the angle of reflection thereby providing the mirror 132 with a beveled appearance, note Futhey et al. in FIG. 11 and at column 8, lines 21-30. Thus, clearly, the image seen by a viewer is the actual top surface of the Futhey et al. optical film 130 which provides the simulated beveled surface. Hence, the simulated beveled surface seen by an observer is the actual outer surface of the optical film 130 provided with the grooves and the beveled surfacing is not a surface other than an actual surface of the film 130. Further, the simulated beveled surface seen is coincident with the upper surface of the Futhey et al. optical film 130.

Similarly, Tachikawa et al. neither teaches nor suggests the "plurality of ridges and grooves ..." recited in independent claim 1 nor can the structure disclosed by Tachikawa et al. perform the function recited for Applicant's claimed structure. Tachikawa et al. discloses an optical recording medium or disk including a substrate whose upper surface as shown in FIGS. 1 and 3 is provided with a series of concentric circles providing concavities and convexities so that reflected light is diffracted. Note Tachikawa et al. at column 2, lines 3-5 and line 30. Tachikawa et al.'s optical disk is for being illuminated by a laser to record information. The optical image, if there is one, provided by the Tachikawa et al. optical disk is coincident with the top surface of the substrate provided with the concentric circles or else the laser obviously could not read the stored information.

It is submitted that the combination of Futhey et al. and Tachikawa et al. is an impermissible hindsight rejection, and a cannibalization and recombination of selected features, which are not permitted by well settled controlling law.

Representative of such law is ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Further in In re Geiger, 2 U.S.P.Q. 2d 1276, 1278 (3rd Cir. 1987) the Court reversed the decision of the Patent Office Board of Appeals rejecting a claim for obviousness under 35 U.S.C. §103 and stated, inter alia, "obviousness cannot be established by

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combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination."

Neither Futhey et al. nor Tachikawa et al. includes any teaching, suggestion or incentive for combining their respective structures. Accordingly, it is submitted that Independent claim 1, and claims 2-12 dependent thereon directly or indirectly define non-obvious subject matter over Futhey et al. in view of Tachikawa et al.

Referring to the independent rejection of dependent claims 11 and 12 in view of the above-noted combination of Futhey et al. and Tachikawa et al. and further in view of Martin '618, it is submitted that Martin adds nothing to the above-noted inadequacies of Futhey et al. and Tachikawa et al. as combining references for properly rejecting Applicant's claims. Martin '618 discloses fire-resistant retroreflective material. Light is reflected directly back to the eye of the viewer. The retroreflective material of Martin is formed of cube-corner or prism retroreflectors as shown in the various FIGS. and which retroreflectors are not the "plurality of parallel ridges and grooves ..." recited by independent claim 1 on which dependent claims 11 and 12 depend and hence the combination of structural elements defined by dependent claims 11 and 12 as dependent on independent claim 1 is neither taught nor suggested in either Futhey et al., Tachikawa et al. or Martin. Accordingly, it is again submitted that dependent claims 11 and 12 are patentable over Futhey et al. In view of Tachikawa et al. and further in view of Martin. It is further submitted that the addition of Martin et al. as a combining reference is an impermissible hindsight recannibalization prohibited by the above-cited controlling law.

Further, it is submitted that Tachikawa et al. is non-analogous art and therefore cannot properly be combined with Futhey et al. for an obviousness rejection. Tachikawa et al. does not disclose an optically decorative product as defined by Applicant's claims. To the contrary, Tachikawa et al. discloses an optical recording medium or disk whose visual effect is not for being viewed by the eye of a human observer but instead is for being illuminated by laser light to provide optically read information. The optical reading is provided by light

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diffraction and the clear teaching of Tachikawa et al. is that their unidentified irregular surface shown in the drawings is merely a well known diffraction grating comprised of concavities and convexities defining concentric circles so that diffraction of reflected light is caused--note Tachikawa et al., column 2, lines 13-17. To rely on a reference under 35 U.S.C. §103, it must be analogous prior art (see MPEP 2141.01(a)). The disclosure of Tachikawa et al. is neither in the field of Applicant's endeavor nor is it reasonably pertinent to the particular problem with which Applicant's invention is concerned, namely, providing the above-noted and claimed "a color effect image such that the layer of transparent polymeric material has an appearance other than a surface of said layer of transparent polymeric material and said image being other than coincident with said opposed surfaces." Clearly, Tachikawa et al. is in a different field from that of Applicant-- optically decorative product versus a laser read optical disk. Further, Tachikawa et al. would not commend itself to an inventor, such as Applicant, in considering the problem of providing an optically decorative product for being viewed by the eye of a human observer and which optically decorative product provides a color effect image which has an appearance other than the surface of the material in which the parallel ridges and grooves providing the image are formed and wherein such image is other than coincident with the opposed surfaces of the transparent material in which such parallel ridges and grooves are formed. As noted above, Tachikawa et al. discloses a common diffraction grating comprised of "concavities and convexities," defining "concentric circles" and neither teaches nor suggests Applicant's claimed "plurality of parallel ridges and grooves wherein the parallel ridges are formed by facets defining a convex surface joined by surfaces forming steps connecting the adjacent facets." Since Tachikawa et al.'s common diffraction grating comprised of such convexities and concavities will not provide an appearance other than the actual surface provided with such diffraction grating and will not provide an image not coincident with the diffraction grating of Tachikawa, Tachikawa et al. would not commend itself to an inventor's attention in providing Applicant's claimed optically decorative product.

Accordingly, it is further submitted that since Tachikawa et al. is non-analogous

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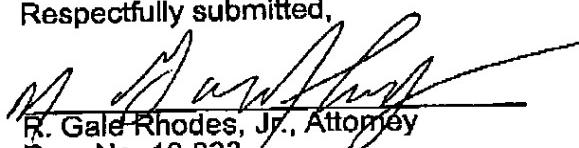
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art its combination with Futhey et al. and Martin for an obviousness rejection is improper and that independent claim 1 and dependent claims 2-12 dependent directly or indirectly on independent claim 1 are not obvious in view of these combined references.

In view of the foregoing, Applicant submits that all pending claims are allowable. Accordingly, both reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

6/10/04


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